



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,299	03/04/2002	Basil Naji	131279 - 1144	6646

7590

07/12/2006

Robert J. Ward
Gardere Wynne Sewell LLP
1601 Elm Street, Suite 3000
Dallas, TX 75201

EXAMINER

MARCANTONI, PAUL D

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,299

Applicant(s)

NAJI ET AL.

Examiner

Paul Marcantoni

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicants' amendment and response of 6/2/06 has been considered but is not convincing.

35 USC 102/103:

Claims 1 and 3-14 are rejected under 35 USC 102(b) as anticipated by, or in the alternative, under 35 USC 103(a) as obvious over Groppo Jr et al. '230 or Sakai et al. '013.

Note: Gebhardt '985 has been withdrawn because it only teaches adding cenospheres with a particle size of 50 to 125 microns to cement. Thus, his cenospheres are not inclusive of applicants' first portion of a particle size of about 10 microns maximum.

Onan et al. '521 has been withdrawn only because it teaches Class C fly ash (applicants range of components reads upon Class "F" fly ash) with an amount of CaO of 29.1 wt% versus applicants' maximum wt% CaO of 20 wt%.

35 USC 103 (combination rejection):

Claims 1 and 3-14 are rejected under 35 USC 103(a) as obvious over Groppo Jr et al. '230 or Sakai et al. '013 in view of McOnie et al. '832, Blankensburg et al. (abstract), and Otte-Witte (abstract).

Objection to Original Specification:

See non-final rejection of 12/2/05 for specifics on p.6 of this office action.

New Matter:

Claims 1 and 3-14 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

See non-final rejection of 12/2/05 for specifics on p.6 of this office action.

35 USC 112 Second Paragraph:

Claims 1 and 3-14 are rejected under the first paragraph of 35 USC 112 second paragraph as failing to set forth the subject matter which the applicants regard as their invention.

See non final rejection of 12/2/05 for specifics on p.7-8 of this office action.

Response:

The applicants have corrected some issues under 35 USC 112 pointed out by examiner in first office action. However, the examiner maintains that there is no distinguishing between the first portion and second portion (larger size fraction and smaller size fraction) because the specification defines the smaller portion as having a 10 micron maximum size and the larger portion having a 100 micron maximum size. Nowhere in the "originally presented claims" nor in the original disclosure/specification do applicants indicate that their "larger" portion must be greater than 10 microns. The applicants cannot imply that is what they meant after submission of their invention because it may very well be that applicants

meant the larger size portion to be inclusive of particle size fly ash of greater than zero to about 100 microns maximum size. The examiner can only interpret what applicants present to him and *there is absolutely no literal statement that the larger portion is greater than 10 microns or has a range of about 10 microns to about 100 microns.*

The applicants argue that Groppo does not teach a dewatering aid. The examiner notes that the new use of a known composition (ie Class "F" fly ash which is what applicants ranges of components read upon) is not a patentable distinction. Further, the alleged "new" use is not new because fly ash as a dewatering aid is old and known in the art as shown by the secondary references.

The applicants also argue that Groppo does not teach the applicants' claimed particle size range. The examiner disagrees and notes that all particle sizes smaller than 75 microns still read upon both alleged groupings of first and second portion class F fly ash as set forth by applicants in their claims. The applicants also cannot distinguish between the two portions because applicants are held to how they define each portion from their original disclosure and they define the first portion as having a size of 10 microns maximum and a second portion as having a particle size of 100 microns maximum. Nowhere do they state that the second portion must be greater than 10 microns because they do not provide literal support for any teaching that the larger portion must be greater than 10 microns but less than 100 microns. It never says that anywhere in the

original disclosure (claims or specification). It is also noted that applicants could still have a particle size of, for example an average particle size of 5 microns as their alleged "larger fly ash portion" and an average particle size of 3 microns for their "smaller fly ash portion" and still meet the definition of the original disclosure without any mention that the larger size fraction being greater than 10 microns.

The applicants also argue intended use (ie dewatering aid) as not within the teaching of Sakai. In rebuttal, the new use of a known composition (in this case the abundant quantities of class F fly ash which applicants invention basically reads upon) is not a patentable distinction. Further, the secondary references teach that the use of fly ash as a dewatering aid is old and known in the art. The applicants also argue particle size range for Sakai yet it still reads upon the applicants' claimed particle size ranges.

The applicants also argue "free or vanishing CaO" yet this would not appear relevant to the teaching of Sakai which teaches fly ash in applicants' claimed range also like applicants added to a hydraulic cement.

The applicants again argue that they use two different particulate portions. They may say so yet their ranges as provided in their original disclosure still overlap because nowhere in the original disclosure do they state that the larger fly ash portion must be greater than 10 microns. There is no literal support for this limitation and applicants cannot assume it is evident as shown by the example provided by examiner (larger portion of fly ash of average particle size 5

microns but less than 10 microns maximum and a "smaller" portion of fly ash of average particle size 3 microns).

The applicants argue that it is improper for examiner to combine the secondary references teaching fly ash is known and old as a dewatering aid. The examiner disagrees and notes that if it is known in the art for this property than it is certainly proper to combine this teaching with other fly ash references to teach that fly ash functions as a dewatering aid.

The applicants state that the examiner has not provided a reasonable explanation of his **objection to the specification** and why it is not enabled. The examiner has consistently maintained that applicants do not clearly distinguish their smaller size portion fly ash fraction from their larger size portion fly ash because there is no literal support or statement that the larger size portion "must" be greater than 10 microns. Thus, both ranges can still overlap and again, please refer to the example provided by examiner showing that the particle sizes can still be less than 10 microns and meet the definition of a "larger size fraction" and "smaller size fraction". Thus, the applicants' examples and specification are not enabling because there is no distinguishing between these two alleged portions and applicants do not particularly point out in their examples any specific particle size ranges in their reference to "larger size portion fly ash" and "smaller size portion fly ash". Again, there is still the possibility that in the examples that the larger size portion can have an average particle size of 5 microns (and be less than 10 microns as required by first portion and less than 100 microns as

required by second portion) and have a smaller size portion of average particle size 3 microns which also meets the definition of both larger and small size portions.

The applicants disagree with the examiner's New Matter rejection of claims. The examiner maintains there is no original support for "100 microns or less" or "10 microns or less" from the original disclosure. Applicants have deleted "or less" in claim 1 for the larger portion (100 micron max portion) but have not deleted "or less" for the 10 micron portion. Claim 1 still states 10 microns "or less". This is not a suggestion but an observation that applicants appear to state they deleted it but have not.

The applicants also maintain that the specification clearly points out two particle size components of fly ash that are allegedly not overlapping and they maintain that "because the first portion is 10 microns or less, it goes *without saying* that the second portion would *typically* be greater than 10 microns. The applicants have just made the examiner's point as to why "but an average particle size of greater than 10 microns" for the larger portion is new matter. First, if it goes without saying, why does this new matter limitation need to be added at all to any claim including claim 10? Second, if it goes without saying then applicants admit they do not say or state for the record that there is any literal support for greater than 10 microns for the particle size range of the larger portion, it is clear this is new matter because it was never stated as part of the original disclosure. Third, the examiner has already provided repeated times an

example of fly ash having an average particle size range of 5 microns but having particle sizes less than 10 microns maximum size and 100 microns maximum size and 3 microns (with the same conditions for less than 10 microns and 100 microns maximum respectively) which means that it does NOT go without saying that the larger fly ash portion must be greater than 10 microns. There again is no literal support for the larger particle size fraction being greater than 10 microns. Fourth, the applicants provide more support to the examiner's position by stating that the second portion "typically" would be greater than 10 microns. If applicants were certain that the larger portion "must" be greater than 10 microns, they most certainly would have used the word "must" and not "typically". Typically means to the examiner that his examples are proper and there is no requirement anywhere in the specification that the larger size fly ash fraction "must" be greater than 10 microns nor again is there any literal support for this limitation. It thus remains new matter.

The examiner maintains that applicants claims are also indefinite because they do not particularly point out and distinctly claim their alleged first and second portions and how they are distinguishable. The examiner maintains that both portions would overlap for the reasons already discussed above. Further, the fact that the applicants maintain that one portion is larger does not mean the larger portion can be 5 microns average particle size and a smaller portion be 3 microns average particle size without even touching upon the issue of whether


the larger particle size range is greater than 10 microns. Applicants arguments are thus not convincing and the finality of this office action is now proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul Marcantoni
Primary Examiner
Art Unit 1755